

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT BROWN,
ROBERT HORVITZ, and DANIEL R. ROSEN

Appeal No. 2001-0624
Application No. 08/204,052

ON BRIEF

Before, WINTERS, ADAMS and MILLS, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

VACATUR and REMAND TO THE EXAMINER

Having reviewed the record in this appeal, we have determined that the rejection under 35 U.S.C. § 112, first paragraph is not based upon the correct legal standards. Accordingly we vacate¹ the rejection under 35 U.S.C. § 112, first paragraph. It also appears that appellants' Brief is defective in that it does not address the rejection of claim 134 under 35 U.S.C. 35 U.S.C. § 112, first paragraph. Therefore, we remand the application to the examiner to consider the following issues and take appropriate action.

¹ Lest there be any misunderstanding, the term "vacate" in this context means to set aside or to void. When the Board vacates an examiner's rejection, the rejection is set aside and no longer exists.

I. Improper New Ground of Rejection:

According to the examiner (Answer, page 2, ¶ 9), “[t]here is no prior art of record relied upon in the rejection of claims under appeal.” Notwithstanding this statement, the examiner relies on two references, Lannfelt² and Mullins³, to support her rejection of claims 109 and 119-134 under 35 U.S.C. § 112, first paragraph. Our review of the record indicates that the examiner relied on both Lannfelt and Mullins in the Office Action, mailed August 14, 1997 (Paper No. 25), however, the examiner withdrew her reliance on Mullins in the subsequent Final Office Action, mailed May 11, 1998 (Paper No. 28). Cf. Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys., 804 F.2d 659, 663, 231 USPQ 649, 651 (Fed. Cir. 1986), cert. denied, 480 U.S. 933 (1987) (“Every point in the prior action of an examiner which is still applicable must be repeated or referred to, to prevent the implied waiver of the requirement.”).

As set forth in In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) (“[w]here a reference is relied on to support a rejection, whether or not in a ‘minor capacity,’ there would appear to be no excuse for not positively including the reference in the statement of the rejection”). Therefore, in our opinion, the examiner’s renewed reliance on Mullins, in the Answer,

² Lannfelt et al. (Lannfelt), “Alzheimer’s disease: molecular genetics and transgenic animal models,” Behav. Brain Res., Vol. 57, pp 207-213 (1993).

³ Mullins et al. (Mullins), “Transgenesis in Nonmurine Species,” Hypertension, Vol. 22, No. 4, pp 630-33 (1993).

amounts to a new ground of rejection. As set forth in 37 C.F.R. § 1.193(a)(2) “[a]n examiner’s answer must not include a new ground of rejection....”

Accordingly, we vacate the rejection of claims 109 and 119-134 under 35 U.S.C. § 112, first paragraph and remand the application to the examiner for further consideration.

II. Defective Appeal Brief:

According to appellants (Brief, page 7), “[t]he issue raised in this appeal is whether the Examiner erred in finding that the applicants’ specification failed to enable the practice of claims 109 and 119-134, under 35 U.S.C. § 112, first paragraph.” In response, the examiner finds (Answer, page 2, ¶ 6), “appellant’s [sic] statement of the issues in the brief is correct.” This, however, is not the case before us on appeal.

According to the Answer two issues are presented for our review. First, the rejection of claim 134 under 35 U.S.C. § 112, first paragraph, “as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Answer, page 3. Second, the rejection of claims 109 and 119-134, under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” Answer, page 4.

While the Brief addresses the second issue, it does not appear to address the first. Stated differently, the brief does not contain arguments of the appellants with respect to each of the issues presented for review in 37 CFR § 1.192(c)(6), and the basis therefore, with citations of the authorities, statutes, and parts of the record relied on as required by 37 CFR § 1.192(c)(8). As set forth in 37 CFR § 1.192(d) “if a brief is filed which does not comply with all the requirements of paragraph (c), the appellant will be notified of the reasons for noncompliance.” On this record, appellants were not so notified. Accordingly, we remand the application to the examiner to take appropriate action.

OTHER ISSUES

While we take no action on the merits of this appeal, we make the following observations:

There are several instances in the Answer where the examiner makes an unsupported finding of fact. See e.g., Answer, page 4 “[i]t is well known in the art that there are certain integral aspects to making and using a transgenic mouse”; Answer, page 5, “the art teaches that ALS ... is associated with certain mutated SOD-1 polypeptides.” Upon further prosecution, we encourage the examiner to support her findings of fact with appropriate evidence. Findings of fact, as well as the conclusions of law, must be made in accordance with the Administrative Procedure Act, 5 U.S.C. 706 (A), (E) (1994). See Zurko v. Dickinson, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

In addition, we note that the examiner may have misapprehended the scope of appellants' claimed invention. To emphasize this point we reproduce appellants' claim 109 below, emphasis added:

109. A transgenic mouse having somatic and germ cells containing a transgene, said transgene encoding and expressing a neurodegenerative disease-causing mutant SOD-1 polypeptide.

According to the examiner (e.g., Answer, page 5), "the mouse is not claimed to express the transgene." If, upon further prosecution, the examiner continues to interpret the claimed invention in this manner, then the examiner should favor the record with a clear explanation as to why the word "expressing" is not considered a limitation in the claimed invention.

We are not authorizing a Supplemental Examiner's Answer under the provisions of 37 CFR § 1.193(b)(1). Any further communication from the examiner which contains a rejection of the claims should provide appellants with a full and fair opportunity to respond. This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01(D) (8th ed., August 2001).

It is important that the Board be informed promptly of any action affecting the appeal in this case.

VACATED and REMANDED

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Sherman D. Winters)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Donald E. Adams)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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Demetra J. Mills)	
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